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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,274	02/16/2004	Giovanni M. Della-Libera	MS1-1858US	2211

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EXAMINER	
LOUIE, OSCAR A	

ART UNIT	PAPER NUMBER
2136	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/780,274	DELLA-LIBERA ET AL.	
	Examiner	Art Unit	
	Oscar A. Louie	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *02/04; 03/04; 07/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This first non-final action is in response to the original filing of 02/16/2004. Claims 1-48 are pending and have been considered as follows.

Examiner's Note

1. The Applicant appears to be attempting to invoke 35 U.S.C. 112 6th paragraph in Claims 38-48 by using "means-plus-function" language. However, the Examiner notes that the only "means" for performing these cited functions in the specification appears to be computer program modules. While the claims pass the first test of the three-prong test used to determine invocation of paragraph 6, since no other specific structural limitations are disclosed in the specification, the claims do not meet the other tests of the three-prong test. Therefore, 35 U.S.C. 112 6th paragraph has not been invoked when considering these claims below.

Claim Objections

2. Claims 19 & 37 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of their respective previous claims.

- Claim 19 is a medium (i.e. computer-readable media) that refers back to Claim 1. The Office considers any claim that refers to another claim as dependent thereon, i.e. a dependent claim. Since Claim 1 is a method claim comprising three steps and Claim 19 fails to add, delete, or change any of these steps, Claim 19 fails to further limit its parent claim.

- Claim 37 is a medium (i.e. computer-readable media) that refers back to Claim 20. The Office considers any claim that refers to another claim as dependent thereon, i.e. a dependent claim. Since Claim 20 is a system claim comprising two components and Claim 37 fails to add, delete, or change any of these components, Claim 37 fails to further limit its parent claim.

The examiner notes that Claims 19 & 37 will be interpreted as "a machine readable medium having instructions" for the considerations below. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

3. Claim 20 is objected to because of the following informalities: Line 2 of Claim 20 recites "obtaining" which should be "...obtain..." Appropriate correction is required.

Specification

4. The use of the trademarks "Kerberos" and "Windows Server" on page 9 lines 1 & 8 have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The examiner notes that corrections to acknowledge these trademarks or any other trademarks found throughout the applicant's specification should be capitalized and accompanied by one of the commonly used symbols for each recitation of a trademark (e.g. KERBEROS™, WINDOWS SERVER™ 2003, etc).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 9 recites the limitation "the method" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 19, 20, 37, & 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Choy (US-6141754-A).

Claims 1, 20, & 38:

Choy discloses a method, a system, and a machine-readable medium having components comprising,

- "receiving a message having an associated token" [Fig 5 illustrates the reception and transmission of a message];
- "the token is associated with a subject" (i.e. "rather is associated with a specific user") [column 5 lines 44-45];
- "obtaining a first claim from the token" (i.e. "The distributed content entity includes a protection specification 301 and an information entity") [column 5 lines 31-32];
- "the claim comprises a statement about the subject" (i.e. "a user privilege") [column 5 line 42];
- "selectively mapping the first claim to a second claim" (i.e. "The information entity and protection specification can be associated with one another so that referential integrity is maintained") [column 6 lines 8-10].

Claims 19 & 37:

Choy discloses a machine-readable medium having components comprising,

- "a machine readable medium having instructions/the modules for performing the method of/recited in claim 1/claim 20" (i.e. "The invention is further directed to a program product, embodied on a computer-readable medium") [column 4 lines 30-31].

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 2-5, 12-16, 21-23, 30-34, 39-40, & 43-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choy (US-6141754-A).

Claim 2:

Choy discloses a method, as in Claim 1 above, but does not explicitly disclose,

- "obtaining another claim from the token"

however, Choy does disclose,

- "The distributed content entity includes a protection specification 301 and an information entity" [column 5 lines 31-32];

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to include, "obtaining another claim from the token," in the invention as disclosed by Choy since it is implied that a method which includes a step for receiving a message would receive at least one message, thereby obviating that more than one (i.e. another) message and its embedded contents would be obtained.

Claims 3, 4, 21, 22, 39, 40, & 45:

Choy discloses a method, a system, and a machine-readable medium having components, as in Claims 1, 20, & 38 above respectively, but does not explicitly disclose,

- "rejecting the message as a function of the first claim"
- "rejecting the message as a function of the second claim"

however, Choy does disclose,

- "the access checking unit 401 consults the user privilege unit 402. If the user has the appropriate privileges to access the collection the access checking unit determines whether the requested information entity exists in the collection (i.e., the protected information entity storage unit" [column 9 lines 57-62];

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to include, "rejecting the message as a function of the first claim" and "rejecting the message as a function of the second claim," in the invention as disclosed by Choy since the access checking unit is determining whether the requested information entity exists in the collection which is based on some criteria from the user (i.e. first claim, second claim, etc).

Claims 5 & 23:

Choy discloses a method and a system, as in Claims 1 & 20 above respectively, but does not explicitly disclose,

- "forming a claim collection that includes the first and second claims"

however, Choy does disclose,

- "Within a storage layer or repository which stores the information entity, the information entity preferably references its corresponding protection specification, thereby linking the information entity with the protection specification. Here, the referencing, or linking, is within a metadata database which contains metadata for the information entity" [column 5 lines 66-67 & column 6 lines 1-4];

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to include, "forming a claim collection that includes the first and second claims," in the invention as disclosed by Choy since it is reasonable to expect that the storage of information entities (i.e. claims) is a repository (i.e. collection) of organized data.

Claims 12, 30, & 43:

Choy discloses a method, a system, and a machine-readable medium having components, as in Claims 1, 20, & 38 above respectively, but does not explicitly disclose,

- "sending a return message to a sender of the message"
- "the return message includes information regarding the second claim"

however, Choy does disclose,

- "a message is returned indicating the requested information entity is not present in the data collection" [column 11 lines 34-35];

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to include, "sending a return message to a sender of the message" and "the return message includes information regarding the second claim," in the invention as disclosed

by Choy since a return message would typically have additional information upon a failed condition for the purposes of providing information for the reason of failure (i.e. information regarding the second claim).

Claims 13 & 31:

Choy discloses a method and a system, as in Claims 12 & 30 above respectively, but does not explicitly disclose,

- "the information regarding the second claim comprises the second claim"

however, Choy does disclose,

- "an information entity 302 in which the protection specification 301 is always "attached" to the information entity" [column 5 lines 33-35];

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to include, "the information regarding the second claim comprises the second claim," in the invention as disclosed by Choy since information which is "attached" to a first set of information generally would coincide or relate to itself (i.e. second claim comprises the second claim). That is, if the second claim did not comprise of at least itself at one point in time, then the second claim would not be the second claim.

Claims 14-16, 32-34, 44, 46, & 47:

Choy discloses a method, a system, and a machine-readable medium having components, as in Claims 1, 20, & 38 above respectively, but does not explicitly disclose,

- "obtaining a third claim from the first claim"
- "obtaining a third claim from the second claim"
- "selectively rejecting the first claim"

however, Choy does disclose,

- "The information entities and operations are particular to a specific information system, whereas the users can be generalized to include user accounts, roles and groups. Typically, the presence of an ACL represents an access authorization" [column 1 lines 33-37];

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to include, "obtaining a third claim from the first claim" and "obtaining a third claim from the second claim" and "selectively rejecting the first claim," in the invention as disclosed by Choy since access control lists typically have many combinations of rules for each user, where the first rule and the second rule may be applied to the first user and where rules for users may be created from other rules as necessitated by their level of authorization (i.e. a third claim from the first claim).

11. Claims 6, 8-11, 24, 26-29, 41, & 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choy (US-6141754-A) in view of R. Fielding (RFC 1808).

Claims 6, 8-11, 24, 26-29, 41, & 42:

Choy discloses a method, a system, and a machine-readable medium having components, as in Claims 1, 20, & 38 above, but does not disclose,

- "obtaining a resource identifier from the message"
- "the resource identifier comprises a property of the message"
- "obtaining a resource identifier from a computing system performing the method"
- "the resource identifier comprises a property of the computing system's runtime environment"

- "a resource corresponding to the resource identifier is stored by the computing system"

however, R. Fielding does disclose,

- "A Uniform Resource Locator (URL) is a compact representation of the location and access method for a resource available via the Internet. When embedded within a base document, a URL in its absolute form may contain a great deal of information which is already known from the context of that base document's retrieval, including the scheme, network location, and parts of the url-path. In situations where the base URL is well-defined and known to the parser (human or machine), it is useful to be able to embed URL references which inherit that context rather than re-specifying it in every instance" [page 1];

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to include, "obtaining a resource identifier from the message" and "the resource identifier comprises a property of the message" and "obtaining a resource identifier from a computing system performing the method" and "the resource identifier comprises a property of the computing system's runtime environment" and "a resource corresponding to the resource identifier is stored by the computing system," in the invention as disclosed by Choy for the purposes of providing embedded information for a resource available via the Internet.

12. Claims 7 & 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choy (US-6141754-A) in view of R. Fielding (RFC 1808) and in further view of Clark et al. ("XML Path Language").

Claims 7 & 25:

Choy and R. Fielding disclose a method and a system, as in Claims 6 & 24 above respectively, but do not disclose,

- "obtaining the resource from the message comprises applying an XPath expression"

however, Clark et al. do disclose,

- "Xpath gets its name from its name from its use of a path notation as in URLs" [pages 3];

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to include, "obtaining the resource from the message comprises applying an XPath expression," in the invention as disclosed by Choy and R. Fielding for the purposes of "navigating through the hierarchical structure of an XML document" [R. Fielding page 3].

13. Claims 17, 18, 35, 36, & 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choy (US-6141754-A) in view of Lynch (US-6487600-B1).

Claims 17 & 35:

Choy discloses a method and a system, as in Claims 6 & 24 above respectively, but does not disclose,

- "the token is received out-of-band from the message"

however, Lynch does disclose,

- "To enhance security of these tokens, initial sets of tokens will be exchanged via a secure channel or via secure delivery. Alternatively, an initial set of tokens may be exchanged via multiple channels" [column 29 lines 36-39];

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to include, "the token is received out-of-band from the message," in the invention as disclosed by Choy for the purposes of there being a low probability existing that an attacker could listen to all, or most of the channels so as to intercept all token pieces and reconstruct the tokens.

Claims 18, 36, & 48:

Choy discloses a method, a system, and a machine-readable medium having components, as in Claims 1, 20, & 38 above respectively, but does not explicitly disclose,

- "sending the message, the token and a second token to another entity"
- "the second token includes information related to the second claim"

however, Choy does disclose,

- "Primary migration of tokens occurs when the token passes from one network member to another network member. Secondary migration occurs when the same token passes to a third, fourth, fifth, etc., network member" [column 29 lines 45-49];

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to include, "sending the message, the token and a second token to another entity" and "the second token includes information related to the second claim," in the invention as disclosed by Choy since "all of this information may be used when a network member

questions another network member for authentication purposes. Further, all of this information may be used by the network members in referring to particular tokens that are used for encryption/decryption purposes" [column 29 lines 55-59].

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Oscar Louie whose telephone number is 571-270-1684. The examiner can normally be reached Monday through Thursday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami, can be reached at 571-272-4195. The fax phone number for Formal or Official faxes to Technology Center 2100 is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OAL
09/06/2007

Nasser Moazzami
Supervisory Patent Examiner

9/7/07